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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,587	09/15/2003	Kuo-Jung Hsu	TOP 322	8059
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RABIN & Berdo, PC 1101 14TH STREET, NW SUITE 500 WASHINGTON, DC 20005				
EXAMINER				
SHERMAN, STEPHEN G				
ART UNIT		PAPER NUMBER		
2629				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,587

Applicant(s)

HSU, KUO-JUNG

Examiner

STEPHEN G. SHERMAN

Art Unit

2629

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-38 is/are allowed.
- 6) ☒ Claim(s) 39-41 is/are rejected.
- 7) ☒ Claim(s) 42-44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/003)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date: _____
- 6) ☐ Notice of Informal Patent Application
- 7) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed 22 January 2010.

Claims 25-44 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 39-41 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Cho (US 6,219,038).

Regarding claim 39, Kawa et al. disclose a notebook computer with a hidden touch pad (Drawing 1), comprising:

a display (Drawing 1, 3.),

a main portion pivotally connected with the display and allowing the display to pivot between a closed position and an opened position (Drawing 1, 2), and including a housing, wherein the housing has a first surface to be adjacent to the display when the display is in the closed position, a second surface formed opposite to the first surface (Drawing 3b and paragraph [0023] explain that the body 2 has an outside, i.e. first surface and an inside, i.e. second surface.),

a touch pad disposed on the second surface (Drawing 3b shows that touchpad portion 53 is received by the body 2 on the inside surface.);

wherein a second identification portion is formed on the first surface and corresponding to the touch pad, thereby to identify the position of the touch pad (Paragraphs [0029] and [0030]).

Kawa et al. fail to explicitly teach that a first identification portion is formed on the second surface.

Cho discloses a notebook computer where a main body as a first surface and a second surface, wherein the second surface has a first identification portion onto which the touch pad is disposed (Figures 1 and 2, where Figure 2 shows that the inner surface of the main portion had an "identification portion" made by 76/78/80 which identifies where the touch pad is received.).

Therefore, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the teachings of Cho in the notebook computer taught by Kawa et al. such that the portion where the touchpad is received is easily identifiable.

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Cho (US 6,219,038) and further in view of Garner (US 6,501,462).

Regarding claim 40, Kawa et al. and Cho disclose the notebook computer as claimed in claim 39.

Kawa et al. and Cho fail to teach that the second identification portion is surrounded by a flange.

Garner discloses of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to a touchpad (Figure 1, item 39 and column 4, lines 5-12. The examiner interprets that item 39 is a flange which surround the touch pad portion item 35.).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the flange taught by Garner with the notebook computer taught by the combination of Kawa et al. and Cho in order to provide improved tactile feedback such that the touchpad can be found without looking for it with the eye.

7. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Cho (US 6,219,038) and further in view of Gettemy et al. (US 7,348,964).

Regarding claim 41, Kawa et al. and Cho disclose the notebook computer as claimed in claim 39.

Kawa et al. and Cho fail to teach wherein a thickness of the housing that the first identification portion forms is thinner than that of the housing that the first identification portion does not form.

Gettemy et al. discloses a housing in which an internal surface is thinner at a portion where the touch pad is located than that of the rest of the housing (Figure 3 shows the housing 340, where the internal surface is shown to be thinner where the touch-screen 350 is disposed than at other parts of the housing.).

Therefore, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the teachings of Gettemy et al. in the notebook computer taught by the combination of Kawa et al. and Cho such that the portion where

the touchpad is received is thinner than other portions of the housing in order to facilitate better recognition of a user touching the touchpad device.

Allowable Subject Matter

8. Claims 25-38 are allowed.
9. Claims 42-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indicating allowable subject matter is the inclusion of limitations such as "wherein a ratio between a thickness of the housing that the first identification portion forms and a thickness of the housing that the first identification portion does not form is 1/3-1/2", "wherein a thickness of the housing that the first identification portion forms is about 0.5-0.8 mm", and "wherein a difference between a thickness of the housing that the first identification portion forms and a thickness of the housing that the first identification portion does not form is 0.7-1.0 mm," in combination

with the other recited features of the claims, which are not found singularly or in combination within the prior art.

The closest available prior art references teach of making the housing thinner at one portion than at the other portions but fail to explicitly teach the specific ranges and thickness ratios as disclosed in the claimed limitations.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHEN G. SHERMAN whose telephone number is (571)272-2941. The examiner can normally be reached on M-F, 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen G Sherman/
Examiner, Art Unit 2629

/Amr Awad/
Supervisory Patent Examiner, Art Unit 2629

3 March 2010